

Application No. 09/944,348  
Amendment dated March 2, 2009  
Reply to Office Action of August 28, 2008

### REMARKS

Claims 83, 87, and 88 have been amended to further define Applicant's claimed invention.

In the Office Action, the Examiner rejected claims 83-88 (including independent claim 83) under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander"). Applicant respectfully traverses the rejection for the reasons set forth below.

#### **A. Claim to priority.**

The present application claims priority to and incorporates by reference U.S. Serial No. 08/975,374 ("374 application"), now U.S. Patent No. 6,286,140 ("140 patent"). The claims of the present application are fully supported by the '374 application. For example, support for the claims can be found in the '374 application at least in the original claims as filed (included as Attachment A), and the '140 patent at least at column 4, lines 31-38; column 6, lines 37-52; column 7, lines 31-58; column 8, lines 13-19; column 9, lines 15-31, 66, and 67; column 10, lines 1-24, 66, and 67; and column 11, lines 1-12 and 18-24. The '374 application has a filing date of November 20, 1997, and hence, the claims of the present application are entitled to that priority date. (See Copy of Filing Receipt of the present application included as Attachment B.)

#### **B. Alexander not prior art under 35 U.S.C. § 102(e).**

Alexander has a non-provisional filing date of July 21, 1998. Therefore, the priority date of the claims of the present application pre-date the non-provisional filing date of Alexander. Furthermore, Alexander derives priority from various provisional applications. (See Copy of Certificate of Correction of Alexander included as Attachment C.) Of the various provisional applications relied upon by Alexander for priority, only five (5) have filing dates that pre-date November 20, 1997. These five (5) provisional applications are listed below:

1. Provisional Application No. 60/055,237, filed on August 12, 1997;
2. Provisional Application No. 60/053,330, filed on July 21, 1997;
3. Provisional Application No. 60/055,761, filed on August 14, 1997;

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4. Provisional Application No. 60/061,119, filed on October 6, 1997; and
5. Provisional Application No. 60/034,784, filed on Dec. 19, 1996.

However, even if the Examiner relies on the priority dates of these five (5) provisional applications, Applicant submits that these provisional applications do not satisfy the requirements of 35 U.S.C. § 102(e) for rejecting the claims of the present application.

**1. Alexander not supported by earlier claim to priority.**

According to MPEP § 2136.03 Part III, “[t]he 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications...is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.” (Emphasis in original.) As discussed below, the five (5) provisional applications do not support the portions of Alexander cited by the Examiner in rejecting Independent claim 83.

Independent claim 83, for example only and without limitation, recites a system including “a monitor device for uninterrupted and passive continuous monitoring of television viewer behavior, the monitor device configured for monitoring event data generated upon occurrence of television viewer events and channel change events.<sup>1</sup>” (Emphasis added.) As such, in this example, independent claim 83 requires the monitor device to monitor both television viewer events and channel change events. However, the five (5) provisional applications do not provide support under 35 U.S.C. § 112, first paragraph, for the portions of Alexander cited by the Examiner in rejecting the above-quoted exemplary recitation of independent claim 83. Accordingly, given the priority date afforded the claims of the present application, Applicant submits that the Examiner’s rejection thereof under 35 U.S.C. § 102(e) based on Alexander cannot be maintained.

**2. Alexander not enabled by earlier claim to priority.**

Furthermore, Applicant submits that the five (5) provisional applications are not enabled for supporting the portions of Alexander cited by the Examiner in rejecting at

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the very least the above-quoted exemplary recitation of independent claim 83. According to the Federal Circuit, “[i]n order to enable, the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.” (Minnesota Mining and Manufacturing Co. v. Chemque, Inc., 303 F.3d 1294, 1306 (Fed. Cir. 2002), citing Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-1196 (Fed. Cir. 1999).) Furthermore, according to MPEP § 2121.01, citing Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Educational Research, 346 F.3d 1051 (Fed. Cir. 2003), “[t]he disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.”

Of the five (5) provisional applications having filing dates that pre-date November 20, 1997, only Provisional Application No. 60/055,761 (“761 application”) appears to have any potential relevance to the claimed subject matter of the present application. However, it is submitted that even if it were to be determined that the ‘761 application were to support the portions of Alexander cited by the Examiner in rejecting the above-quoted exemplary recitation of independent claim 83, the ‘761 application only includes generalized disclosure of such subject matter. With respect to the portions of Alexander cited by the Examiner, the generalized disclosure of the ‘761 application does not teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation. Accordingly, Applicant submits that the ‘761 application is not enabled at the very least for rejecting the above-quoted exemplary recitation of independent claim 83, and hence, the Examiner’s rejection thereof under 35 U.S.C. § 102(e) based on Alexander cannot be maintained.

### C. Conclusion.

In conclusion, Applicant submits that independent claim 83 is patentable and that dependent claims 84-88 dependent from independent claim 83, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, in view of the foregoing remarks, it is respectfully

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submitted that the claims are patentable. Accordingly, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: March 2, 2009

By:



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**ATTACHMENT A****CLAIMS**

What Is Claimed Is:

1. A system for monitoring television viewer behavior, which comprises:

a signal receiving device, wherein said signal receiving device further comprises:

a monitoring device for monitoring an occurrence of an event, wherein said event comprises a change of at least one of on/off status of said signal receiving device, a channel change, a volume change, a mute/unmute operation and one of a user one of interactive and non-interactive one of event and operation, wherein said monitoring device generates a digital signal representative of at least one of on/off status of the signal receiving device, channel change, volume change, mute/unmute operation, and user one of interactive and non-interactive one of event and operation;

an event timing device for keeping a real-time record of event time occurrence and for generating a digital signal representative of event time occurrence;

a data latching device for one of latching and storing the digital signals generated by said monitoring device and said event timing device; and

a database for storing the data one of latched and stored by said data latching device.

2. The system of claim 1, which further comprises:

a control device for controlling said signal receiving device;

a television signal receiver for receiving television signals; and

a device for one of transmitting and relaying the received television signals to a television.

3. The system of claim 1, wherein said signal receiving device further comprises:

a viewer input device for facilitating viewer control over said signal receiving device; and

an output device for providing an indication of signal receiving device operation.

4. The system of claim 1, which further comprises:

a central processing computer which is located remotely from said signal receiving device, which further comprises:

a control device for controlling the operation of said central processing computer;

a receiver for receiving data obtained at said signal receiving device;

a memory storage device for storing data obtained from said signal receiving device, and

means for processing said data obtained from said signal receiving device and for generating output data one of indicative of and reflecting viewer behavior.

5. The system of claim 4, wherein said signal receiving device further comprises:

a receiver for receiving signals from said central processing computer; and

a transmitter for transmitting data to said central processing computer.

6. The system of claim 5, wherein said central processing computer further comprises:

a transmitter for transmitting one of control, data and polling signals to said signal receiving device.

7. The system of claim 1, wherein television signals are transmitted via at least one of a television communication system, a telephone communication system, a wireless communication system and a fiber optic communication system.

8. The system of claim 1, wherein said monitoring device comprises at least one of:

a television on/off status monitoring device;

a channel change monitoring device;

a volume change monitoring device;

a mute/unmute status monitoring device; and

a viewer one of interactive and non-interactive event monitoring device.

9. The system of claim 1, wherein said system further comprises:

a remote control device for remotely transmitting control signals to said signal receiving device; and

a remote control receiver for receiving said control signals at the signal receiving device.

10. The system of claim 1, wherein said signal receiving device further comprises:

a receiver for receiving non-television signals from a television signal transmitter; and

a transmitter for transmitting non-television signals to said television signal transmitter.

11. The system of claim 1, wherein said database comprises time-stamped data representative of at least one of

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on/off status of the signal receiving device, channel change, volume change, mute/unmute operation, and a user one of interactive and non-interactive one of event and operation.

12. A system for monitoring television viewer behavior, which comprises:

a plurality of signal receiving devices for receiving television signals from a transmitter, wherein said plurality of signal receiving devices at least one of monitors and records data one of indicative of and reflecting respective viewer behavior in exercising control over a respective signal receiving device; and

a central processing computer for processing data obtained from said plurality of signal receiving devices.

13. The system of claim 12, wherein each one of said plurality of signal receiving devices comprises:

a monitoring device for monitoring changes in at least one of on/off status of the signal receiving device, a channel change, a volume change, a mute/unmute operation and a user one of interactive and non-interactive one of event and operation, wherein said monitoring device generates a digital signal representative of at least one of on/off status of the signal receiving device,

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channel change, volume change, mute/unmute operation, and user one of interactive and non-interactive one of event and operation;

an event timing device for keeping a real-time record of event time occurrence and for generating a digital signal representative of event time occurrence;

a data latching device for one of latching and storing the digital signals generated by said monitoring device and said event timing device; and

a database for storing the data one of latched and stored by said data latching device.

14. The system of claim 12, wherein each of said plurality of signal receiving devices further comprise:

a control device for controlling each of said plurality of signal receiving devices;

a television signal receiver for receiving television signals; and

a device for one of transmitting and relaying the received television signals to a television.

15. The system of claim 12, wherein said central processing computer further comprises:

a control device for controlling the operation of said central processing computer;

a receiver for receiving data from said plurality of signal receiving devices;

a memory storage device for storing data obtained from said plurality of signal receiving devices, and

means for processing said data obtained from said plurality of signal receiving devices and for generating output data one of indicative of and reflecting viewer behavior.

16. The system of claim 12, wherein said central processing computer further comprises:

a transmitter for transmitting one of control, data and polling signals to said plurality of signal receiving devices.

17. The system of claim 12, wherein television signals are transmitted via at least one of a television communication

system, a telephone communication system, a wireless communication system and a fiber optic communication system.

18. The system of claim 12, wherein at least one of said plurality of signal receiving devices comprises at least one of:

a television on/off status monitoring device;

a channel change monitoring device;

a volume change monitoring device;

a mute/unmute status monitoring device; and

a viewer one of interactive and non-interactive event monitoring device.

19. The system of claim 15, wherein said memory storage device comprises data regarding at least one of viewer and demographic information.

20. A method for monitoring television viewer behavior, which comprises the steps of:

monitoring changes in at least one of on/off status of a signal receiving device, a channel change, a volume change, a mute/unmute operation and a user interactive and non-interactive one of event and operation;

generating a first digital signal representative of at least one of on/off status of the signal receiving device, channel change, volume change, mute/unmute operation, and user interactive and non-interactive one of event and operation;

generating a second digital signal representative of the time of occurrence of said at least one of on/off status of a signal receiving device, a channel change, a volume change, a mute/unmute operation and a user interactive and non-interactive one of event and operation; and

time-stamping said first digital signal with said second digital signal to generate a third digital signal; and

storing said third digital signal.

21. The method of claim 20, further comprising the step of:

transmitting said third digital signal to a central processing computer.

22. The method of claim 20, further comprising the steps of:

processing said third digital signal data; and generating an output data set representative of viewer behavior.

23. The method of claim 20, further comprising the steps of:

obtaining third digital signal data for a plurality of viewers;

processing said third digital signal data; and generating an output data set representative of viewer behavior.

24. The method of claim 20, which further comprises the step of:

determining if a viewer is an authorized viewer.

25. A system for monitoring television viewer behavior,

which comprises:

a device for receiving television signals;

a device for monitoring a viewer's actions in controlling

a television;

a device for generating information representative of a viewer's actions;

a device for recording the information representative of the viewer's actions;

a device for time-stamping the information representative of the viewer's actions; and

a memory device for storing the information representative of the viewer's actions.

26. A method for monitoring television viewer behavior,

which comprises:

receiving television signals;

monitoring a viewer's actions in controlling a television;

generating information representative of a viewer's actions;

recording the information representative of viewer's actions;

time-stamping the information representative of the viewer's actions; and

storing the information representative of the viewer's actions.

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

ATTACHMENT C

PATENT NO. : 6,177,931 B1  
DATED : January 23, 2001  
INVENTOR(S) : Ronald Alexander et al.

Page 1 of 2

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title page.

Item [63], Related U.S. Application Data, replace the paragraph with the following – Provisional application No. 60/055,237, filed on Aug. 12, 1997, provisional application No. 60/068,375, filed on Dec. 22, 1997, provisional application No. 60/053,330, filed on Jul. 21, 1997, provisional application No. 60/055,761, filed on August 14, 1997, provisional application No. 60/061,119, filed on Oct. 6, 1997, provisional application No. 60/071,811, filed on Jan. 20, 1998, provisional application No. 60/071,812, filed on Jan. 20, 1998, provisional application No. 60/071,882, filed on Jan. 26, 1998, and PCT International Application No. PCT/US97/23852, filed on Dec. 19, 1997, which in turn claims priority of provisional application No. 60/034,784, filed on Dec. 9, 1996 --.

Column 1.

Line 10, replace the paragraph with the following – This application claims priority of U.S. Provisional Patent Application Nos. 60/055,237 (“ADVERTISING MESSAGES DEPENDING ON ACCESS CONTENT”), filed Aug. 12, 1997, Ser. No. 60/068,375 (“SELECTION OF ADVERTISING MESSAGES IN AN EPG”) filed Dec. 22, 1997, Ser. No. 60/053,330 (“EPG WITH ADVERTISING MESSAGES”)) filed Jul. 21, 1997, Ser. No. 60/055,761 (“ELECTRONIC PROGRAM GUIDE FEATURES”), Ser. No. 60/061,119 (“TV GUIDE PLUS+”) filed Oct. 6, 1997, Ser. No. 60/071,811 (“SYSTEMS AND METHODS FOR DISPLAYING TARGETED ADVERTISING IN AN EPG”), filed Jan. 20, 1998, Ser. No. 60/071,812 (“ELECTRONIC PROGRAMMING GUIDE SYSTEM WITH GRAPHICAL ENHANCEMENT CAPABILITY”) filed Jan. 20, 1998, and Ser. No. 60/071,882 (“SYSTEMS AND METHODS FOR DISTRIBUTING ADVERTISING IN AN ELECTRONIC PROGRAMMING GUIDE”) filed Jan. 26, 1998,

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,177,931 B1  
DATED : January 23, 2001  
INVENTOR(S) : Ronald Alexander et al.

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It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 1 (cont'd).

and PCT International Application No. PCT/US97/23852, Attorney Docket No. 31912PCT/LTR/E190 ("EPG WITH ADVERTISING INSERTS") filed Dec. 19, 1997, which in turn claims priority of U.S. Provisional Patent Application No. 60/034,784 ("EPG WITH ADVERTISING INSERTS") filed Dec. 19, 1996, the disclosures of all of which are incorporated herein by reference, as if fully stated here, for all purposes --.

Signed and Sealed this

Eleventh Day of November, 2003



JAMES E. ROGAN  
*Director of the United States Patent and Trademark Office*